

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK A. WALKER

Appeal No. 2000-0528
Application No. 09/209,702

ON BRIEF

Before STAAB, McQUADE and JENNIFER D. BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 46, 47, 51, 55 and 56, which are all of the claims pending in this application.¹

¹ Claims 48-50, 52-54 and 57-59 were canceled in an amendment (Paper No. 7) filed subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to a planar board for use in fishing at least one fishing line at a predetermined distance from a trolling boat. An understanding of the invention can be derived from a reading of exemplary claims 46, 51 and 55, which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wille	4,028,840	Jun. 14, 1977
Anderson	4,920,689	May 1, 1990
Reiger	5,867,932	Feb. 9, 1999 (filed Sep. 23, 1996)

The following rejections are before us for review.

- (1) Claims 46, 47, 51, 55 and 56 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wille.
- (2) Claims 46, 47, 51, 55 and 56 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Anderson.
- (3) Claims 46, 47, 51, 55 and 56 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Reiger.

Reference is made to the brief (Paper No. 10) and the answer (Paper No. 11) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Before addressing the examiner's rejections based upon prior art, it is essential that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Further, it is well settled that terms in a claim should be construed as those skilled in the art would construe them. See Specialty Composites v. Cabot Corp., 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977).

Each of the claims on appeal requires a first "fishing line release" and a second "fishing line release." We understand "fishing line release" to be a term of art which would be recognized by one of ordinary skill in the field of the appellant's invention as a clamp or similar structure which holds a fishing line but which is designed to release the line upon application of

a sufficient pull force on the line, such as when a fish is hooked. Accordingly, we interpret the claim terminology "fishing line release" as structure which is designed to hold fishing line and release the fishing line upon the application of sufficient pull force on the fishing line.

Rejection (1)

The examiner's basis for rejecting the independent claims as being anticipated by Wille is set forth on page 4 of the answer as follows:

Wille discloses a planar board comprising a base (10), a first line release (12, 13 attached to base by 14-16) mounted to the base at a middle, a second line release (24) at a front having a positive retaining means (generally 24 with 25, 26, 30, & 31), depression of the second line release (via tab 50) allowing a fishing line to be inserted behind the positive retaining means (fishing line can be inserted behind one of 25 or 26 when tab 50 is depressed creating a gap there beneath for the line to be threaded thereunder tab 50 and about stud 25 or washer 26), and at least one line retainer (33) attached to the base.

The structure that the examiner considers to be a first release is a tow bar 12 which is bent so that its distal end 13 extends upwardly and slightly forwardly. The distal end 13 of the tow bar is provided with a ring or other means to which a tow line 17 extending from a boat 18 may be attached (column 2, lines 31-48). The tow bar is not provided with structure for holding a line and releasing the line upon the application of a predetermined pull force thereon and, thus, is not a "fishing line release" as we have interpreted that terminology, *supra*. Moreover, with regard to claim 46, even if the tow bar, with its distal ring or the like, were considered to be a "release," the fishing line 49 is not inserted into the tow bar or the ring as required by the claim.

Accordingly, we cannot sustain the examiner's rejection of independent claims 46, 51 and 55, or claims 47 and 56 which depend from claims 46 and 55, respectively, as being anticipated by Wille.

Rejection (2)

Each of the claims on appeal requires a first fishing line release, a second fishing line release and at least one line retainer. Anderson, however, discloses only one fishing line release (returning member 40). From our perspective, neither the eyelet 20, which the examiner has considered to be a fishing line release, nor the other eyelet 22 is in fact a release as we have interpreted that term, *supra*, because these eyelets are not designed to hold the line and release it upon application of a predetermined pulling force.

In light of the above, we cannot sustain the examiner's rejection of the claims as being anticipated by Anderson.

Rejection (3)

In rejecting the claims as being anticipated by Reiger, the examiner considers the guide peg 63 and guide peg casing 64 to be the first release, a clasp 14 to be the second release and the breakaway clip 60 to be the retainer. With regard to the "positive retaining means" recited in claims 46 and 55, the examiner (answer, pages 5-6 and 10) takes the position that the arms 39, 40 and calipers 42 of the clasp 14 positively retain the line therebetween for preventing the line from escaping a first end (the ends of the calipers 42). Further, the examiner points out

that either of the arms forms, with the caliper attached thereto, a "peg" as recited in claims 47, 51 and 56.

The examiner's position in this regard appears to us to be based on an unreasonable interpretation (see answer, pages 9 and 10) of the claim terminology "positive retaining means" and "preventing." From our perspective, one of ordinary skill in the art, having read the appellant's disclosure at page 12, the last paragraph, and page 44, the second paragraph, would understand the "positive retaining means" for preventing the line from escaping therefrom as structure which retains the line and does not give way to tugging force applied to the line.² Consequently, such a person would not construe the clasp arms of Reiger, which give way to the force of a fish tugging on the line and release the line therefrom (column 5, line 64, to column 6, line 5), as a "positive retaining means" as recited in claims 46 and 55. Further, while the biasing force applied to the arms of the release clasp 14 does provide some resistance against the escape of the line from the end of the clasp, it does not "prevent" the line from escaping as one of ordinary skill in the art would understand this term in the context of the appellant's invention.

For the foregoing reasons, we do not share the examiner's opinion that the arms of the clasp 14 meet the "positive retaining means for preventing a fishing line from escaping . . ."

² In proceedings before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

limitation of claims 46 and 55 or the "peg for preventing a fishing line from escaping . . ."
limitation of claim 51. Accordingly, we shall not sustain rejection (3).

NEW GROUND OF REJECTION

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new
rejection.

Claims 51, 55 and 56 are rejected under 35 U.S.C. § 102(b) as being anticipated by
Wille.

Wille discloses a base (body 11), a first fishing line release (secondary line holder and
release 33) mounted to the base at substantially a middle thereof, a second fishing line release
(primary line holder and release 24) mounted to the base at substantially a front thereof, and a
line retainer (towbar 12 and the ring on its distal end 13) which retains a tow line. While the
tow bar is intended for attachment of a tow line rather than a fishing line, the fishing line 49 is
"insertable" into the ring at the distal end of the tow bar as recited in claim 55.³

In order to meet a "means-plus-function" limitation, the prior art must (1) perform the
identical function recited in the means limitation and (2) perform that function using the
structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch Inc. v.
Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994);
Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed.

³ Claims 51 and 55 do not require that any line, much less the fishing line, actually be inserted into or
retained by the "line retainer."

Cir. 1993); Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989).

Claim 55 recites a "positive retaining means for preventing a fishing line from escaping a first end of said second fishing line release." Wille's second fishing line release 24 includes a threaded stud 25 affixed to and extending laterally from the body 11, a back up washer 26, a clip member 27, a pair of washers 29 separated by a coil spring 30, and a wing nut 31. The threading of the wing nut onto the stud 25 against the compressive force of the spring produces a clamping force between the abutting faces of the washer 26 and clip member 27 for clamping the fishing line 49. As pointed out by the examiner on page 7 of the answer, a fishing line threaded or looped around the threaded stud 25 would be retained by the second line release 24 regardless of the tension or strike exerted upon the line. Thus, the threaded stud 25 performs the identical function recited in the means-plus-function limitation "positive retaining means for preventing a fishing line from escaping a first end of said second fishing line release" of claim 55. Moreover, the stud 25, by blocking passage of a looped fishing line to thereby prevent its escaping from an end of the release 24, performs the same function in substantially the same manner to produce substantially the same results as the reciprocating pin disclosed in the appellant's specification and is substantially identical in structure⁴ to the appellant's reciprocating pin, in that it takes the form of a pin or peg passing through the middle of the clamping

⁴ See Odetics Inc. v. Storage Tech. Corp., 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1999).

surfaces of the release. Therefore, we have determined that the stud 25 is an equivalent of the reciprocating pin, or other retaining means (specification, page 44), disclosed in the appellant's specification and responds to the positive retaining means for preventing a fishing line from escaping a first end of the fishing line release, as recited in claim 55.

The stud 25 is a peg⁵, as required by claims 51 and 56. Further, with regard to claim 55, as explained in column 4, lines 15-23, depression of the lever 50 on the clip member 27 forces the back edge of the clip member 27 to open against the compression of the spring 30 so that the line 49 can be inserted between the abutting faces of the back up washer 26 and clip member 27. A length of line passing around the stud 25 between the back up washer and clip member is "behind" the stud as viewed from the diametrically opposite side of the stud.

CONCLUSION

To summarize, all of the examiner's rejections of claims 46, 47, 51, 55 and 56 under 35 U.S.C. § 102 are reversed. A new rejection of claims 51, 55 and 56 is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

⁵ A projecting pin or bolt used to hang things on, fasten ropes to, mark degrees of measurement or keep the score in a game, etc. (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)).

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37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
- (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

LAWRENCE J. STAAB
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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